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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,743	12/03/2003	Dean S. Paris	1221-0001	6830
26568	7590	11/30/2005	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			CHEN, VIVIAN	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/726,743

**Applicant(s)**

PARIS, DEAN S.

**Examiner**

Vivian Chen

**Art Unit**

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

1. Claim 9 has been cancelled by Applicant.
2. The allowability of claims 1-6 have been withdrawn in view of newly discovered art.

New grounds of rejection based on the newly discovered art follow:

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “thermoset” in claims 1-2, 8 are used by the claim to mean “heatset”, while the accepted meaning is “a crosslinked, non-thermoplastic polymer.” The term is indefinite because the specification does not clearly redefine the term.

***Claim Rejections - 35 USC § 103***

1. Claims 1-4, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/31346, in view of SATO ET AL (US 5,128,411).

WO '346 discloses a laminate comprising a plurality of polyester (e.g., polyethylene terephthalate) layers bonded together by means of polar adhesive layers, wherein the film comprises a core polyester layer adhesively bonded to an overlay laminate on both surfaces, wherein the overlay laminates themselves comprise two polyester layers bonded together by an adhesive layer, wherein the polyester layers are biaxially oriented, and wherein the laminate is suitable for forming stiff, durable articles such as cards. (entire document, see Figure 1, pages 4-5, 8-14) However, the reference does not explicitly disclose the use of polyethylene adhesive or heatset films.

NEWTON discloses that it is well known in the art to use biaxially oriented polyester film which have been heat-set after orientation in order to obtain strong, dimensionally stable articles such as cards. (line 10-60, col. 5).

SATO ET AL discloses that it is well known to use polyethylene-based adhesives to adhere polyester layers together to form multilayer structures (lines 45-55, col. 3; line 58, col. 7 to line 11, col. 8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adhere biaxially oriented heat-set polyester films with the adhesives of SATO ET AL in order to form the laminate of WO '346 in order to obtain mechanical strong, durable laminates capable of withstanding tensile or compressive loads in film plane directions.

***Allowable Subject Matter***

3. Claims 5-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

2. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to disclose or suggest polyester laminates wherein the laminates comprises two film assemblies adhesively bonded to each surface of a core layer, wherein the assemblies each comprise two biaxially oriented polyester film layers bonded together by an adhesive layer, wherein various layers have the recited thicknesses (claims 5-6).

***Response to Arguments***

3. Applicant's arguments filed 8/12/2005 have been considered but are moot in view of the new ground(s) of rejection.

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*Conclusion*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 23, 2005



Vivian Chen  
Primary Examiner  
Art Unit 1773